

### **REMARKS**

In the September 18, 2006 Office Action, the drawings and specification were objected to and claims 1-12 stand rejected in view of prior art. Claim 4 was also rejected for failing to indicate and claim particularly and distinctly the subject matter that Applicant regards as the invention. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the September 18, 2006 Office Action, Applicant has amended the specification and claims 4, 8, 9 and 10 as indicated above. Also Applicant has added new independent claims 13 and 14. Thus, claims 1-14 are pending, with claims 1, 13 and 14 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

#### ***Drawings***

On page 2 of the Office Action, the Office Action, the drawings were objected to as failing to comply with 37 CFR §1.83(a). In particular, the Office Action indicates that the “operator actuating member” and the “positioning member” are not shown in the drawings.

In response, Applicant has amended the specification to clarify the “operator actuating member” and the “positioning member”. Applicant believes that the drawings comply with 37 CFR §1.83(a). Applicant respectfully requests withdrawal of the objections to the drawings.

#### ***Specification***

In number paragraph 1 of the Office Action, the specification was objected to for typographical errors and failing to comply with 37 CFR §1.75(d)(1). In response, Applicant has amended the claims to provide proper antecedent basis for the limitations of claims 8, 9 and 10. In other words, claims 8, 9 and 10 have been amended to conform to the specification.

Applicant believes that the specification is now correct and complies with 37 CFR §1.75(d)(1). Withdrawal of the objections is respectfully requested.

***Claim Rejections - 35 U.S.C. §112***

In number paragraphs 2 and 3 of the Office Action, claim 4 was rejected under 35 U.S.C. §112, second paragraph. In response, Applicant has amended claims 4 to remove the objectionable term (i.e., "slightly" has been removed).

Applicant believes that the claims now comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

***Rejections - 35 U.S.C. § 103***

In number paragraphs 4 and 5 of the Office Action, claims 1 to 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable. In particular, claims 1 to 9 stand rejected over U.S. Patent No. 5,957,002 (the Ueng patent) in view of U.S. Patent No. 4,184,380 (the Rivin patent), while claims 10 to 12 stand rejected over U.S. Patent No. 5,957,002 (the Ueng patent) in view of U.S. Patent No. 4,184,380 (the Rivin patent) and further in view of U.S. Patent No. 5,104,358 (the Kobayashi patent). In response, Applicant respectfully traverses these rejections.

More specifically, independent claim 1 is a generic claim that covers bicycle components (e.g., bicycle shift operating devices and bicycle derailleurs) having a ***buffer member in a positioning mechanism***. While the Ueng patent and the Kobayashi patent have positioning mechanisms as claimed, they fail to disclose a ***buffer member*** as claimed. Rather, the Office Action relies upon the Rivin patent to show the use of a buffer member between gear teeth. Applicant respectfully disagrees with this combination. The Rivin patent is directed to ***meshing gear teeth for mechanical power transmission***. In particular, under the Summary of the Invention, the Rivin patent states at column 2, lines 15 to 17 that the

“invention is directed to an improved form of toothed gears for mechanical power transmission”, and states at column 2, lines 31 to 34 that that “invention solves the problem of reduced power transmission since the clearances between engaging teeth are eliminated thereby allowing both profiles of each tooth to transmit power”. The Ueng patent and the Kobayashi patent do not have meshing gear teeth and applying a buffer member to them as suggested in the Office Action would not solve the problem noted in the Rivin patent.

Under U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of success for adding the buffer member of the Rivin patent to ratchet member 43 of the Ueng patent to create the Applicant's unique arrangement.

Moreover, Applicant believes that dependent claims 2 to 12 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 2 to 12 are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

#### *New Claims*

In addition, Applicant has added new independent claim 13 and 14 to more particularly claim the two disclosed embodiments. Applicant believes that the prior art of

record fails to render the claimed invention obvious for the same reason as mentioned above with respect to claim 1.

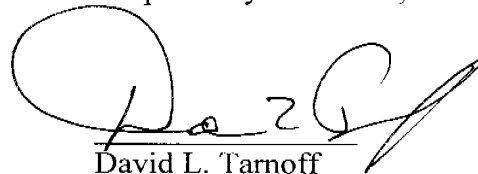
***Prior Art Citation***

In the Office Action, additional prior art references were made of record. Applicant believes that these references do not render the claimed invention obvious.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1 to 14 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,



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Dated: 2 - 20 - 07

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